

Remarks

In an Office Action dated November 20, 2002, the Examiner rejected claims 45, 57, 69 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 51, 68, and 72 of U.S. Patent No 5,960,412 and claims 1, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054. The Examiner also rejected claims 45, 50-53, 57, 62-65, 69, 74-77 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,552,994 issued to Cannon et al (Cannon Patent) in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent). The Examiner also rejected claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of Official Notice regarding express couriers. The Examiner also rejected claims 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of U.S. Patent issued to Hayes. The Examiner also rejected claims 54-56,66-68, 78-80 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of Chartock and further in view of the Mail List Management articles cited by the Examiner.

Applicant submits a Terminal Disclaimer herewith, the following arguments in support of patentability to traverse the Examiner's rejection of the claims, and requests that the Examiner reconsider the rejections of the claims contained in this Office Action and issue a Notice of Allowance in this case.

Double Patenting Rejection

The Examiner rejected claims 45, 57, 69 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 51, 68, and 72 of U.S. Patent No 5,960,412 and claims 1, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054. The Examiner noted: "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application claim subject matter pertaining to system, method, means, and program code of

Page 10 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

electronically viewing, ordering, and delivering a social expression card to a recipient."

Applicant submits a Terminal Disclaimer herewith to traverse the Examiner's rejection of the claims, and requests that the Examiner reconsider the rejections of the claims contained in this Office Action and issue a Notice of Allowance in this case.

Rejection of claims 45, 50-53, 57, 62-65, 69, 74-77 under 35 U.S.C. §103(a)

The Examiner rejected claims 45, 50-53, 57, 62-65, 69, 74-77 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,552,994 issued to Cannon et al (Cannon Patent) in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent), noting (in pertinent part) with respect thereto:

Cannon et al teach a system, method, means, databases, and programs for viewing, ordering, and printing social expression cards for customers who remotely order greeting cards over a computer network. Cannon et al. teach printing cards at the user location or at remote locations, a database defining the layout of selected cards by occasion (e.g. Birthday), displaying graphical images, personalizing messages, transacting multiple card orders, recipient information, envelope printing, and delivery modes. Cannon et al. teach a [sic] an order information database, multiple modes of delivery (e.g. mail or delivered as noted in prior art), order information storage and retrieval, and unique order identifiers to retrieve orders (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67,68); col. 1, line 15 through col. 5, line 39). Cannon et al. teach storing order information in at least one database, the data in the order information database including recipient data records for a customer, and each recipient data records containing data that defines a recipient, and logically linking order information with card image, personalized messages, receiver and sender data, and order status data (see at least Fig 19 (70, 71); col. 17, lines 3-8; lines 22-25; col. 18, lines 29-31). Cannon et al. teach linking the recipient data with social expression card data containing data which defines at least one social expression card, and forming linked data (see at least Fig. 19 (71, 72, 73); col. 18, lines 29-31). Cannon et al. further teach the following:

Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59),

Assigning each customer order with a unique order code and the order code being stored in the order information database and retrieved by the card printing facility for processing (see at least Fig. 19 (74); col. 4, lines 6-8; col. 18, line 59),

Receiving an order initiated by a customer transmitting the order to a card printing site (see at least col. 17, lines 22-25),

Printing and shipping cards ordered by a customer or multiple

customers, with order information stored in an order information database (see at least Fig. 19 (70, 71); Fig. 20b (79, 80)),

Updating the order information to reflect the date the orders [sic] was processed and shipped (see at least Fig. 19 (85, 86); col. 19, lines 63-65), and

Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent (see col. 3, lines 50-55).

The Examiner further notes that:

Cannon et al. teach all of the above as noted under the 103(a) rejection and teach a) linking recipient data with greeting card data, b) the customer accessing the system to initiate delivery of a greeting card by a fulfillment center to a recipient, c) storing data in at least one database the information recipient data for said customer, and d) a plurality of recipient greeting card orders being placed in a order information database for daily processing (see at least Fig. 19 (70, 71); Fig. 20b (79, 80); col. 18, lines 34-36, 42-45; col. 19, lines 17-22), but are unclear as to whether the plurality of recipient data in the order information database belongs to the same sender. Gordon et al. teach a pertinent problem of providing a more practical means of initiating delivery of information to a plurality of recipients. Gordon et al. teach providing a practical means for fax machine users to automatically fax documents to multiple destinations, and further teach this as an advantage since it only ties up a broadcast user's machine for one outgoing transmission (see at least col. 3, lines 48-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Cannon et al. to provide a more practical means of initiating delivery to a plurality of recipients in a single process as taught by Gordon et al., in order to eliminate singly repeated start and stop processes associated with each separate greeting card order, and thereby attract more customers to the service due to the additional convenience.

Applicant has reviewed the Examiner's comments and believes that the Cannon Patent fails to show or suggest the structure recited in Applicant's claims 45, 50-53, 57, 62-65, 69, 74-77, for the reasons articulated below. Applicant believes that claims 45, 50-53, 57, 62-65, 69, 74-77 are allowable over the cited Cannon Patent under 35 U.S.C. §103(a), given the proper application of 35 U.S.C. §103(a) to Applicant's claims.

Characterization of the Cannon Patent

In referring to the Cannon Patent, the Examiner mistakenly notes that the Cannon Patent is capable of: "Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59)".

In fact, the Cannon Patent discloses a kiosk-based card ordering system where the user can only order a single card for a single recipient in a single transaction from a terminal, either a kiosk, personal computer, or cable television set-top box. The preferred embodiment of the system for printing social expression cards disclosed in the Cannon Patent consists of a personal computer-based card kiosk which enables a user to select and order a single greeting card from a remotely located card printing facility, using the personal computer-based card kiosk to access a database of card designs. The database of card designs can be located in the kiosk or at the printing facility. One significant limitation of the Cannon system for printing social expression cards is that it is a single transaction card purchase system that does not provide the user with the capability to store data relating to: multiple recipients, recipient addresses, recipient occasions, order history, order status. This single card focus is succinctly described in the Cannon Patent: "The user can order a selected card to be printed and input information to personalize the card. The order is then electronically transmitted to a card printing facility for printing." (column 4, lines 64-67) The user's transaction for the printing of a single card for a single recipient is processed by the printing facility of the Cannon system and the data, input by the user relating to the recipient and the occasion, are thenceforth unavailable to the user, since the Cannon Patent fails to even hint at maintaining a consumer accessible database of consumer information that enables a consumer to populate a database with a plurality of recipient data records. In addition, the Cannon Patent is totally devoid of even a hint of printing multiple cards pursuant to the single card order entry transaction. Thus, the focus of the Cannon system for printing social expression cards is exclusively to print a single social expression card for a single recipient via a transaction-based public kiosk, with all of the data input by the user being transient in nature: input by the user, transmitted to the card printing facility

Page 13 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

and forever beyond the reach of the user and discarded once it is used to print the card.

The Examiner mistakenly noted: "Cannon et al teach transacting multiple card orders", and a careful reading of the entirety of the Cannon Patent fails to reveal even a hint of the ability to initiate more than a single card order in a transaction or the ability to order multiple cards in any mode in the single transaction. The Examiner then notes that the Cannon Patent also suggests "Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent". However, it is interesting to note that the Cannon Patent is totally devoid of any suggestion of how to address this problem, since the consumer is unable to access any data stored or processed by the Cannon system once the initial order is placed. The above-noted rhetorical comment in the Cannon Patent is not a disclosure of any teaching of how to solve the problem articulated and therefore does not constitute prior art for the purposes of an obviousness rejection of Applicant's claims.

Characterization of the Gordon Patent

The Gordon Patent discloses a centralized fax store and forward system that functions to receive a fax transmission from an originating machine, then automatically process the transmission to ensure delivery to the listed destination. The Gordon fax forwarding system automatically retries the fax transmission without the need for the originating party's intervention, until delivery is accomplished. The fax can be automatically transferred from a fax forwarding node closest to the originating machine to a fax forwarding node closest to the destination machine, so that the retry process is implemented only on the last segment of the fax transmission path, thereby saving network resources.

As specifically recited in the Gordon Patent, column 2, lines 49-68 and column 3, lines 1-2:

The basic approach is to provide special computer-based fax Store And Forward Facilities (SAFF's) as an integral part of a switched telephone network system. All fax transmissions entered into the network are routed to such a facility, typically geographically near the originating machine, where they are temporarily stored or "spooled" by the computer in a mass storage buffer, such as a magnetic disk.

Page 14 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

The fax message from the originating machine is intended for a destination machine, which may or may not be in a position to immediately answer the call. If the destination machine is within the service region of that SAFF, the system then proceeds to attempt to call the destination fax machine. If the destination machine is within the service area of a different SAFF, the system forwards the fax document data to that facility by long-distance lines, in which case this second facility attempts to call the destination machine. In either case, if contact is established and the message is delivered immediately, the system directs a printed report back to the originating fax machine confirming delivery to the destination machine, and other pertinent data.

.....

Placing the delivering spooling system geographically near the destination machine has the advantage of more economical use of any long-distance lines that may be involved. These lines are used only to move the message from the originator to the spooling system in the vicinity of the destination, which is virtually certain to be successful on the first try. Subsequent attempts to contact the destination machine can be handled more or less locally and need not tie up the bulk of the long-distance facilities.

....

An important feature of the system is that it recognizes all of the documents that are spooled in the system at a given time for a given destination machine. These are identified and linked together to form a message queue for that machine. In this way, once contact is established, all of the waiting messages can be "dumped" to that machine in a continuous batch. Furthermore, if new messages arrive while that dump is occurring, they are simply appended to the end of the active queue and are transmitted when their turn comes. This has the advantage of greatly enhancing the utilization efficiency of a busy destination machine.

Since all outgoing fax documents are temporarily stored at the facility near the originating machine, it is also practical to provide for automatic broadcasting of documents to multiple destinations. Lists of "broadcast groups" of phone numbers can be programmed into the facility by users, or a list of destination phone numbers entered "by hand" at the time of a call. The SAFF can then broadcast the message to every machine of the selected list. This is a great advantage to broadcast users in that they need only tie up their machines for one outgoing transmission, the one to the SAFF. The SAFF copies the message to all of the destination machines as outlined above. In the meantime, the originating machine is

available for receiving or transmitting other documents.

Thus, the fax store and forward system of the Gordon Patent simply is a telephone network queuing system that makes more efficient use of the network resources.

Applicant's Claimed System

In contrast, Applicant's social expressions management system is a centralized e-commerce system which enables a consumer, from any computer terminal, to populate a database with an address book comprising a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards. The consumer has the ability "to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients." Thus, the consumer can execute a transaction that addresses the social expression needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards.

This ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards to facilitate the on-going management, selection, and delivery of social expression cards and enable the consumer to order social expression cards for a plurality of recipients is not even hinted at by the Cannon Patent or the Gordon Patent, yet is specifically recited in Applicant's independent claim 45, for example:

A method for initiating fulfillment of a consumer order in a system where a consumer communicates with an order fulfillment center, the method comprising the steps of:

storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;

linking the recipient data with social expression card data, containing data which defines at least one social expression card, thereby

forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

In fact, in support of Applicant's position, the Examiner asserts that Cannon "do not disclose the customer accessing the databases to make a change to an order." The Examiner focuses on the initial order entry capability of the system of the Cannon Patent, which order entry capability represents a standard mode of placing a one time, single recipient order commonly used by such systems. However, there is no support for the Examiner's position that the Cannon Patent suggests the ability of the consumer to access the databases after placing the order, or the capability to order multiple social expression cards for multiple recipients in the same session, since the Cannon Patent is completely devoid of even a hint of "providing a customer interface to permit said customer to access the data" as is specifically recited in Applicant's independent claim 45. The printing facility 40 of the Cannon Patent is described in excruciating detail (column 14, line 45 - column 15, line 33), including the minutiae of implementation details of the keyboard, mouse, processor, hard drives, modems, software, printer, etc., including a recitation of the most minor product implementation details of each and every element. However, it is important to note that NO REFERENCE is made to a USER INTERFACE anywhere in the specification, drawings or claims (in particular, see Figure 3a, Figure 19, Figure 21 and accompanying descriptions) of the Cannon Patent that would enable the user to access, edit and approve order information that had been previously entered into the system as is suggested by the Examiner. In fact, the Cannon Patent teaches away from this concept, since the printing facility is equipped only with a FAX MODEM (SupraFAXModem V.32bis) to enable order receipt from the various display/order systems 50. The Cannon Patent describes numerous ways for the consumer to fill out and order form via kiosks, cable television systems, personal computer systems, fax forms, and the like, however, once the order form is transmitted to the Cannon printing facility, it is beyond the reach of the consumer, since the Cannon system has no user interface, only a modem for receiving completed card orders.

In addition, the Gordon Patent does not even hint at a system that can be used for order entry or the purchase of consumer goods. The Gordon Patent simply teaches a fax store and forward capability for implementation in communication networks. Therefore, the system of the Gordon Patent is inapplicable to any structure recited in Applicant's claims.

Non-Analogous Art

Applicant believes that the Gordon Patent represents non-analogous art in that this reference is directed to a different field than Applicant's customer order initiation system to the extent that they do not address problems that are at all related to each other and the Gordon reference is not at all related to the problem that Applicant solved.

Applicant's customer order initiation system is directed to a centralized e-commerce system which enables a consumer, from any computer terminal, to populate a database with an address book comprising a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards. The consumer has the ability "to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients." Thus, the consumer can execute a transaction that addresses the social expression needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards.

In contrast, the Gordon Patent does not even hint at a system that can be used for order entry or the purchase of consumer goods. The Gordon Patent simply teaches a fax store and forward capability for implementation in communication networks. Therefore, the system of the Gordon Patent is inapplicable to any structure recited in Applicant's claims.

Therefore, Applicant believes that the Gordon Patent reference is non-analogous art under the standards defined by the courts.

The courts and the MPEP state that to be available as prior art to an inventor, a reference must either be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. The courts have stated:

Page 18 of 26
Serial No.: 09/525,491
Atty Dkt. No. 13212.118 (.121)

In resolving the question of obviousness under 35 U.S.C. § 103 we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside of his endeavor, we only presume knowledge for those areas reasonably pertaining to the particular problem for which the inventor is involved. The rationale behind this rule precluding rejections based on combinations of teachings of references of nonanalogous arts is the realization that an inventor cannot possibly be aware of everything in the art. In re Wood, 220 USPQ 171, 174 (C.C.P.A. 1979)

A reference reasonably pertains to the problem solved by the inventor only if the reference teaches a solution to a problem faced by the inventor, which in Applicant's case is the customer order initiation system. The courts state a reference reasonably pertains to a problem if:

the matter with which it [the reference] deals, logically would have commanded itself to the inventor=s attention in considering his problem.... If a reference disclosure has the same purpose as a claimed invention, the invention relates to the same problem.... If directed to a different purpose, the inventor would accordingly have less motivation or occasion to consider it. In re Clay, 23 USPQ2d 1058, 1060-1061 (Fed. Cir. 1992).

As noted in In re Clay, 23 USPQ2d 1058-1061:

"Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313,315(Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)."

In Re Oetiker 24 U.S.P.Q.2d 1443, 977 F.2d 1443 (Fed.Cir.1992) further addressed the problem:

In this case, Oetiker's invention was an improvement in a "stepless, earless" metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly "hook". This "hook" serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened. Each claim of Oetike's patent was rejected under Sec. 103.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '400 patent. Lauro describes a plastic hook and eye

fastener for use in garments, in which "unitary tabs of sewing needle puncturable plastic material . . . are affixable to clothing and the like by sewing". Oetiker argued that there is no suggestion or motivation to the artisan to combine the teachings of the cited references, and that Lauro is nonanalogous art. Oetiker contended that these references were improperly combined; that a person of ordinary skill, seeking to solve the problem facing Oetiker, would not look to the garment art for the solution. Oetiker also argues that even if combined the references do not render the claimed combination obvious.

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. (The Federal Circuit commented that "Indeed, the argument is not supportable.") However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it related to a hooking problem, as did Oetiker's invention.

Before the Federal Circuit, the Commissioner argued that "all hooking problems are analogous." In his appellate brief, the Commissioner stated that "A disengageable catch, such as that used by Oetiker, is a common everyday mechanical concept that is variously employed in door latches and electrical and other switches, as well as in the hook and eye apparatus disclosed by Lauro". No such references were cited, however. The Court noted that it may take judicial notice of common everyday mechanical concepts in appropriate circumstances, but stated that the Commissioner did not explain why a "catch" of unstated structure in an electrical switch, for example, is such a concept and would have made Oetiker's invention obvious. In fact, the Commissioner did not respond to Oetiker's argument that the cited references provide no teaching or suggestion that Lauro's molded hook and eye fastener, even if combined with Oetiker's '004 clamp, would achieve Oetiker's purpose.

The Federal Circuit concluded that the references were improperly combined and reversed the rejection of Oetiker's claims. The Court stated:

"In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the

Page 20 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."

"It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985)."

"Oetiker's invention is simple. Simplicity is not inimical to patentability. See Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); Panduit Corp. v. Dennison Mfg Co., 810 F.2d 1561, 1572, 1 USPQ2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), cert. denied, 481 U.S. 1052 (1987)."

Further:

"Even though the art disclosed in Sydansk is not within Clay's field of endeavor, the reference may still properly be combined with Hetherington if it is reasonably pertinent to the problem Clay attempts to solve. In re Wood, 599 F.2d at 1036, 202 USPQ at 174. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports the use of that reference in an obviousness rejection."

Thus, the cited Gordon Patent is related to a communication network system used for fax forwarding and does not at all relate in any manner to a centralized e-commerce system which enables a consumer, from any computer terminal, to populate a database with an address book comprising a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards. The Gordon Patent is totally devoid of any hint of the field of e-commerce, or the ability of a customer to create a centralized address book that can be used to facilitate the on-going management, selection, and delivery of social expression cards. Thus, applying the rules articulated by the courts, the Gordon Patent clearly represents non-analogous art and is therefore not available as prior art to an inventor. Thus, the Examiner's 35 U.S.C. §103(a) rejection of Applicant's claims using the Gordon Patent is inappropriate and should be withdrawn.

Obviousness Test

Since the Examiner's rejection of Applicant's claims is based on 35 U.S.C. §103(a), it is relevant to review the application of this rejection.

The MPEP and courts have stated that the Examiner must show the following:

"1.) A motivation or suggestion to combine references, 2.) A reasonable expectation of success from combining the references, and 3.) The combined references teach all of the limitations of the claimed invention." MPEP § 706.02(j); See also *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to meet the first of the above-noted three requirements by the MPEP for *prima facie* obviousness, the following must be shown: 1.) one or more references, 2.) The references were available to the inventor at the time of the claimed Invention, 3.) each of the references teaches an element of the claimed invention, 4.) the prior art contains a suggestion or a motivation to combine the references, 5.) the combination of the references would have made the invention obvious. See *In re Rinehart*, 189 USPQ 143, 147 (C. C. P. A. 1976); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir 1988); *In re Fitch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

As noted above, the Cannon Patent fails to teach all of the recited elements of Applicant's claims. The Examiner admits that Cannon "do not disclose the customer accessing the databases to make a change to an order." The Examiner has therefore

Page 22 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

attempted to supply the elements not shown or suggested by the Cannon Patent based on the teachings of the Gordon Patent. However, as noted above, the Gordon Patent does not even hint at a system that can be used for order entry or the purchase of consumer goods. The Gordon Patent simply teaches a fax store and forward capability for implementation in communication networks. Therefore, the system of the Gordon Patent is inapplicable to any structure recited in Applicant's claims.

Thus, the combination of the Cannon Patent with the Gordon Patent fails to meet the standards set by the Courts to support a valid rejection of Applicant's claims under 35 U.S.C. §103(a).

No Suggestion to Combine – Hindsight Needs to Be Avoided

A brief examination of "hindsight" law as handed down by the Federal Circuit superimposed upon the facts of this case will be helpful. The hindsight approach was criticized in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983):

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

The Federal Circuit repeated its prohibition against "hindsight." In *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434, 1438, 1439 (CAFC 1988), the Federal Circuit held:

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

* * * * *

There is no suggestion in any individual prior art reference of such a combination of location and configuration nor is it suggested by the prior art as a whole. ([I]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention). (Emphasis added; citations omitted)

The proper approach to an obviousness analysis was explained as follows:

Page 23 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

"In order to prevent a hindsight-based obviousness analysis, we have clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed.Cir.1998) ("[T]he Board must identify specifically The reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Dembicza*k, 175 F.3d at 999, 50 USPQ2d at 1617 ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664-5, 57 U.S.P.Q.2d 1161 (Fed. Cir.2000).

Specific demonstration of a motivation to combine is required.

"The district court opinion does not discuss any specific evidence of motivation to combine, but only makes conclusory statements. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Dembicza*k, 175 F.3d at 999, 50 USPQ2d at 1617." *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 U.S.P.Q.2d 1065 (Fed.Cir.2000).

In applying the hindsight test, the Examiner has failed to show: "4.) the prior art contains a suggestion or a motivation to combine the references,", since in fact, both the Cannon Patent and the Gordon Patent teach away from the combination suggested by the Examiner. The absence of even a hint of a user interface contradicts the Examiner's suggestion that with respect to the Cannon Patent "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Cannon et al. to allow customer access to order data once entered to review or modify the order."

Furthermore, the Examiner has shown no combination of references that address Applicant's claimed structure wherein a consumer can execute a transaction that addresses the social expression needs for a plurality of recipients and a plurality of occasions, with Applicant's system maintaining a database to reflect the complex nature of the consumer's social expression needs and to facilitate the on-going management, selection, and delivery of social expression cards. This ability to store a plurality of recipient data records, then link the recipient data with social expression card

Page 24 of 26

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

data to facilitate the on-going management, selection, and delivery of social expression cards and enable the consumer to order social expression cards for a plurality of recipients is not even hinted at by the Cannon Patent or the Gordon Patent, yet is specifically recited in Applicant's independent claim 45, for example.

Thus, Applicant believes that claims 45, 50-53, 57, 62-65, 69, 74-77 are allowable under 35 U.S.C. §103(a) over U.S. Patent No 5,552,994 issued to Cannon in view of U.S. Patent No. 4,994,926 issued to Gordon, since the Cannon Patent and the Gordon Patent both fail to show or suggest the limitations recited in these claims and in fact teach away from the modifications suggested by the Examiner.

Rejection of claims 46-49, 54-56, 58-61, 66-68, 70-73, 78-80 under 35 U.S.C. §103(a)

The Examiner also rejected claims 46, 47, 58, 59, 70, 71 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of Official Notice regarding express couriers. The Examiner also rejected claims 48, 49, 60, 61, 72, 73 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of U.S. Patent issued to Hayes. The Examiner also rejected claims 54-56, 66-68, 78-80 under 35 U.S.C. §103(a) as being unpatentable over the Cannon Patent in view of U.S. Patent No. 4,994,926 issued to Gordon (Gordon Patent) as applied to claims 45, 57, 69 and further in view of Chartock and further in view of the Mail List Management articles cited by the Examiner.

Applicant believes that claims 46-49, 54-56, 58-61, 66-68, 70-73, 78-80 are allowable under 35 U.S.C. §103(a) since they depend on allowable base claims as well as being allowable over the cited Cannon Patent and Gordon Patent individually as well as in view of Official Notice regarding express couriers, in view of the cited Hayes reference and further in view of Chartock and further in view of the Mail List Management articles, since none of these references even hint at Applicant's claimed ability to store a plurality of recipient data records, then link the recipient data with social expression card data to facilitate the on-going management, selection, and delivery of social expression cards and to also enable the consumer to order social expression cards for a plurality of recipients.

Page 26 of 28

Serial No.: 09/525,491

Atty Dkt. No. 13212.118 (.121)

Summary

Applicant respectfully requests a Notice of Allowance in this application in light of the Terminal Disclaimer filed herewith, and the arguments set forth herein. The undersigned attorney requests Examiner Pond to telephone if a conversation could expedite prosecution. Applicant authorizes the Commissioner to charge any additionally required payment of fees to deposit account #50-1848.

Respectfully submitted,
Patton Boggs, LLP

Dated: 11 November 2003

By: 
James M. Graziano, Reg. No. 28,300
Tel: 303-894-6113
Fax: 303-894-9239

Customer No. 24283

Page 26 of 26
Serial No.: 09/525,491
Atty Dkt. No. 13212.118 (.121)